



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,102	12/10/2003	Daniel H. Abelow	03058-004006	7959
26161	7590	12/06/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			DIXON, THOMAS A	
			ART UNIT	PAPER NUMBER
			3639	
DATE MAILED: 12/06/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,102

Applicant(s)

ABELOW, DANIEL H.

Examiner

Thomas A. Dixon

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-101 and 103-140 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 48-89, 98-107, 122-129, 131-133 and 135-140 is/are allowed.
- 6) ☒ Claim(s) 90, 91, 93-97, 108-121, 130 and 134 is/are rejected.
- 7) ☒ Claim(s) 92 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/29/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments / amendments are convincing.
2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 3639

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 48 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,999,908. Although the conflicting claims are not identical, they are not patentably distinct from each other

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 9/29/05 has been considered.

Specification

5. The new title is acceptable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 90-91, 93-97, 108-117, 130, 134 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark et al (4,731,818).

As per Claim 90.

Art Unit: 3639

Clark et al ('818) discloses:

units of a telephonic device that are used by respective users in different locations, see figure 1 (14);

a user interface which is part of each of the units and provides a medium for a two way local interaction between one of the users and the corresponding unit, the user interface is configured to generate information about use of the unit by the user, see column 2, lines 26-33;

a communication element that is associated with each of the units and carries results of the two-way local interaction from each of the units to a central location, see figure 1 (transmission network); and

software that manages interactions of the users in different locations and collection of the results of the interactions at a central location, see figures 2 and 3.

As per Claim 91.

Clark et al ('818) further discloses central telephone network facility, see figure 2 (to central office).

As per Claim 93, 112.

Clark et al ('818) further discloses the user interface is triggered based on user behaviors to generate two-way interactions with each of the users, each of the interactions corresponding to a corresponding specific one of the behaviors, see figure 2 (off hook? yes, insert card signal).

As per Claim 94, 114.

Clark et al ('818) further discloses the software is configured to provide access to the collection of results to the user, see figure 2 (card valid? – no – invalid card signal, yes proceed and further customer's card is billed for the call).

As per Claim 95, 115.

Clark et al ('818) further discloses access to the collection results to vendors of the commodity, see figure 2 (to central office).

As per Claim 96, 116.

Clark et al ('818) further discloses access to the collection results to third parties, see column 3, line 5 - column 4, line 60.

As per Claim 108.

Clark et al ('818) discloses:

units of a commodity that are used by respective users in different locations; see figure 1 (14);

a user interface which is part of each of the units and provides a medium for a two way local interaction between one of the users and the corresponding unit, the user interface is configured to provide instructional information about use of the unit by the user, see column 2, lines 26-33 and column 3, lines 8-25;

Art Unit: 3639

a communication element that is associated with each of the units and carries results of the two-way local interaction from each of the units to a central location, see figure 1 (transmission network); and

software that manages interactions of the users in different locations and collection of the results of the interactions at a central location, see figures 2 and 3.

As per Claim 109.

Clark et al ('818) discloses:

units of a telephonic device that are used by respective users in different locations, see figure 1 (14);

a user interface which is part of each of the units and provides a medium for a two way local interaction between one of the users and the corresponding unit, the user interface is configured to generate information about use of the unit by the user, see column 2, lines 26-33;

a communication element that is associated with each of the units and carries results of the two-way local interaction from each of the units to a central location, see figure 1 (transmission network); and

software that manages interactions of the users in different locations and collection of the results of the interactions at a central location, see figures 2 and 3.

Clark et al ('818) does not specifically disclose use of hypertext, but this limitation of the claims does not distinguish the claimed apparatus from the prior art.

As per Claim 110.

Clark et al ('818) discloses:

units of a commodity that are used by respective users in different locations, see figure 1 (14);

a user interface which is part of each of the units and provides a medium for a two way local interaction between one of the users and the corresponding unit, the user interface is configured to generate information about use of the unit by the user, see column 2, lines 26-33;

a memory that is part of each of the units of the commodity and that stores probes that include information that directs the user interface's interaction with the respective users, see figure 1 (24) and column 3, lines 8-25;

a communication element that is associated with each of the units and carries results of the two-way local interaction from each of the units to a central location, see figure 1 (transmission network); and

software that manages interactions of the users in different locations and collection of the results of the interactions at a central location, see figures 2 and 3.

As per Claim 111.

As described the limitation (use of hypertext) of the claims do not distinguish the claimed apparatus from the prior art.

As per Claim 113.

Art Unit: 3639

Clark et al ('818) further discloses the interactions are triggered based on repeated use of a feature of the commodity, see column 2, lines 26-33 and column 3, lines 8-25;

As per Claim 117.

Clark et al ('818) further discloses the user interface is configured to provide instructional information about use of the unit by the user, see column 2, lines 26-33 and column 3, lines 8-25.

As per Claim 119.

Clark et al ('818) discloses:

units of a commodity that are used by respective users in different locations, see figure 1 (14);

a user interface which is part of each of the units and provides a medium for a two way local interaction between one of the users and the corresponding unit, the user interface is configured to provide instructional information about use of the unit by the user, see column 2, lines 26-33 and column 3, lines 8-25;

a communication element that is associated with each of the units and carries results of the two-way local interaction from each of the units to a central location, see figure 1 (transmission network); and

software that manages interactions of the users in different locations and collection of the results of the interactions at a central location, see figures 2 and 3.

As per Claim 120.

Clark et al ('818) discloses:

units of a telephonic device that are used by respective users in different locations, see figure 1 (14);

a user interface which is part of each of the units and provides a medium for a two way local interaction between one of the users and the corresponding unit, the user interface is configured to generate information about use of the unit by the user, see column 2, lines 26-33;

a communication element that is associated with each of the units and carries results of the two-way local interaction from each of the units to a central location, see figure 1 (transmission network); and

software that manages interactions of the users in different locations and collection of the results of the interactions at a central location, see figures 2 and 3.

Clark et al ('818) does not specifically disclose the information comprises value information about user comprehension or user performance, but this limitation of the claims does not distinguish the claimed apparatus from the prior art.

As per Claim 121.

Clark et al ('818) discloses:

units of a telephonic device that are used by respective users in different locations, see figure 1 (14);

Art Unit: 3639

a user interface which is part of each of the units and provides a medium for a two way local interaction between one of the users and the corresponding unit, the user interface is configured to generate information about use of the unit by the user, see column 2, lines 26-33;

a communication element that is associated with each of the units and carries results of the two-way local interaction from each of the units to a central location, see figure 1 (transmission network); and

software that manages interactions of the users in different locations and collection of the results of the interactions at a central location, see figures 2 and 3.

Clark et al ('818) does not specifically disclose the information comprises value information about marketing or future product design, but this limitation of the claims does not distinguish the claimed apparatus from the prior art.

As per Claim 130.

Clark et al ('818) further discloses the software sends the probes to units of the commodity based on the frequency of contact between the respective units and the central location, see column 2, lines 26-33 and column 3, lines 8-25.

As per Claim 134.

Clark et al ('818) further discloses stored probes includes questions, see column 2, lines 26-33 and column 3, lines 8-25.

7. Claim 118 is rejected under 35 U.S.C. 102(b) as being anticipated by McKenna et al (4,816,904).

As per Claim 118.

McKenna et al ('904) discloses:

units of a commodity that comprises consumer television equipment, the units being used by respective users in different locations, see column 1, lines 30-56;

a user interface which is part of each of the units and provides a medium for a two way local interaction between one of the users and the corresponding unit, the user interface is configured to generate information about use of the unit by the user, see column 1, lines 30-56;

a communication element that is associated with each of the units and carries results of the two-way local interaction from each of the units to a central location, see column 1, lines 30-56; and

software that manages interactions of the users in different locations and collection of the results of the interactions at a central location, see column 1, lines 30-56.

Allowable Subject Matter

8. Claims 92, 97 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claims 48, 98, 135 are allowable.
10. The following is a statement of reasons for the indication of allowable subject matter:

As per Claim 48

The prior art of record, specifically Kaplan, Lohrey et al, Glick and Clark et al do not disclose or fairly teach:

a user interface which is part of each of the units of the commodity, provides a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and is configured to elicit, from a user, information about the user's perception of the commodity;

a memory that is included within each of the units of the commodity and stores results of the two-way local interaction, the results including elicited information about user perception of the commodity.

As per Claim 88

The prior art of record, specifically Kaplan, Lohrey et al, Glick and Clark et al do not disclose or fairly teach:

a user interface which is part of each of the units of the commodity, provides a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and is configured to elicit, from a user, information about the user's perception of the commodity.

As per Claim 135

The prior art of record, specifically Kaplan, Lohrey et al, Glick and Clark et al do not disclose or fairly teach:

eliciting users for their perceptions of respective units of commodity through interactions at user-interfaces of the units of commodity;

generating perception information based on inputs of the users at the respective user-interfaces;

transmitting the perception information to the remote database.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Thomas A. Dixon", with a stylized flourish at the end.

Thomas A. Dixon
Primary Examiner
Art Unit 3639

November 05